

REMARKS

Request to Withdraw Finality of the Office Action

As an initial matter, Applicant requests that the Office withdraw the finality of the last Office Action. According to M.P.E.P. § 706.07(a), a second, or subsequent action on the merits shall be final, except where the Office introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an IDS after first action on the merits. In this case, the Office has purported to maintain the prior rejection set forth in the Office Action mailed May 10, 2000, in response to which no claims were amended by Applicant. However, the Final Office Action included several grounds of rejection not included in the May 10, 2000 Office Action. Specifically, the Office has raised new issues of new matter, lack of written description, and vagueness. See Final Office Action, pages 3-4. Applicant notes that the Office has not specifically recited the claims to be rejected, but has made statements that appear to amount to the same thing. Nevertheless, issues of new matter, lack of written description, and vagueness are grounds for rejection to which Applicant must respond. For this reason, Applicant requests that the finality of the Office Action mailed January 8, 2001, be withdrawn. In any event, the Office should clearly state all outstanding grounds of rejection and withdraw the "observations" as improper and inaccurate so that these matters can be appropriately addressed by way of petition or appeal, should either course of action be necessary.

Rejection Under 35 U.S.C. § 103

The Office has rejected claims 43-62 and 64-67 under 35 U.S.C. § 103 as being unpatentable over EPA 590,604 ("604") in view of U.S. Patent No. 4,874,604 ("Sramek") and Chemical Abstract 89:117546 ("the '546 abstract"), for the reasons set forth at pages 2-3 of the Office Action. Applicant respectfully traverses the rejection for the reasons of record, as well for the additional reasons set forth below.

In the previous Reply of September 28, 2000, Applicant argued that the rejection over '604 in view of Sramek and the '546 abstract does not establish a *prima facie* case of obviousness because there is neither motivation to combine the references nor a reasonable expectation of success. Applicant clearly set forth that there is nothing in the art that directs a person of ordinary skill to choose the film-forming copolymer of the '546 abstract, the composition of '604, and the hair spray compositions of Sramek and combine them. Applicant has further argued that in view of the unpredictability of the chemical arts the expectation for success is not reasonable.

In response, the Office has characterized Applicant's Reply as arguing combination by hindsight, and cited *In re McLaughlin* for the proposition that so long as the rejection takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such hindsight reconstruction is proper. See Office Action, page 3. However, *McLaughlin* does not relieve the Office of its burden of providing proper motivation and a reasonable expectation for success.

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. There must be a reasonable expectation of success. See M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The asserted motivation for combining '604 in view of Sramek and the '546 does not exist. In the paragraph bridging pages 2 and 3 of the Office Action, the Office has stated:

It would have been obvious to one of ordinary skill to add the polymer of '604 to the composition of Sramek to impart freeze-tha[w] resistance and to use the polymer of '546 as a hair setting polymer in view of its high effectness and water resistance. [Emphasis added]

STRAN M AN

This reasoning is incorrect because the references simply do not suggest adding the polymer of '604 to the composition of Sramek to impart freeze-thaw stability. First, Sramek does not teach or suggest to the skilled artisan that there is a need to improve the freeze thaw resistance of the Sramek hairspray compositions. In fact, Sramek does not mention freeze-thaw resistance. Why then would the ordinary artisan, reading the teachings of Sramek, see any need to modify Sramek to improve freeze-thaw resistance? The answer is, they would not.

Second, even if, for the sake of argument, the ordinary artisan did see a need to modify Sramek to improve freeze thaw resistance, '604 does not suggest adding the '604 copolymer to the Sramek composition. Rather, the '604 teaches that compositions have excellent freeze thaw stability may be obtained by "carefully controlling the particle size of the copolymer and introducing a surfactant effective to enhance freeze-thaw stability of the composition". See '604, page 2, lines 33-37. Further, the '604 provides testing examples directed to improving freeze-thaw stability of polymer compositions. In Example 36, the freeze thaw stability of the polymer compositions of Examples 9 was shown to be adjusted from 0 (unacceptable) to 3 (acceptable) by varying the pH. See '604, page 9. In Example 37, the freeze-thaw stability of a polymer composition having similar characteristics to that described in Example 9, was tested and found to be improved by the addition of non-ionic surfactants. See '604, pages 9-10. However, none of the examples or teachings of '604 suggest adding the '604 copolymer to improve freeze-thaw stability of another polymer solution. Therefore, the ordinary artisan looking to improve freeze thaw stability and reading '604, would at best be motivated to try controlling the particle size of the Sramek copolymer, adjusting the pH, or introducing a surfactant into the Sramek compositions, rather than adding the '604 copolymer to another polymer to adjust freeze thaw stability.

In addition, the skilled artisan would not be motivated to combine the teaching of '604 and Sramek because the '604 reference is generally directed to aqueous polymer

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

compositions while Sramek is generally directed to resins which are dissolved in organic solvents, such as alcohols, which are taught to include only a minimum amount of water. Furthermore, the '604 reference teaches the freeze-thaw stability problem occurs in aqueous based compositions, so there is no motivation to apply the '604 teachings to the Sramek compositions which contain only a minimal amount of water.

The '604 reference is generally directed to "Aqueous, anionic, acrylic polymer compositions" (see '604 Abstract). The '604 reference teaches that "[t]he polymer compositions may be formulated into hairspray compositions which have an all aqueous carrier, i.e., where no VOC's are present, or which contain a VOC concentration of up to about 80 weight percent, or more." Preferred concentrations for water content include from about 2 to 20, about 20 to 50, about 50 to 80 and about 80 to 99 weight percent of the hairspray composition. Although relatively low amounts of water are contemplated, the prepared examples contain a majority of water. See Example 38, which contains 335 g of deionized water compared to only 100 g of alcohol. Furthermore, the '604 discloses that the problem of "freeze-thaw" stability is a problem of aqueous based polymer compositions, but does not disclose that there is any such problem for non-aqueous based compositions. See page 2, lines 24-30.

In contrast, Sramek teaches hairspray resins which are dissolved in hydrocarbon solvents, such as C₂ to C₄ alcohols. While the hairspray compositions may also contain water as a solvent, Sramek teaches that it is advisable to use the minimum amount of

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, CARRETT,
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000

water needed since water tends to release the curls in the hair. Sramek goes on to teach that generally less than 10% of the total composition, exclusive of propellant, is water. See Sramek, column 5, line 59 to column 6, line 1.

Thus, the skilled artisan, looking at the teachings of the '604 reference and Sramek, would not be motivated to combine them because the '604 reference is generally directed to aqueous based polymer compositions, while Sramek generally teaches hydrocarbon based compositions in which the amount of water is minimized to avoid the undesirable effect of releasing curls in the hair. Furthermore, the teaching of the '604 reference that freeze-thaw stability is a problem which occurs in aqueous based polymer compositions would not have suggested to the skilled artisan that the compositions of Sramek, which contain only a minimum amount of water, have freeze-thaw stability problems. Thus, there would have been absolutely no motivation to try to improve the freeze-thaw stability of the Sramek compositions, as indicated by the Office.

In addition to the lack of motivation for combining the '604 polymer with the Sramek composition, there is also no reasonable expectation of success. The '604 reference teaches enhancing freeze-thaw stability of an aqueous, anionic polymer composition by adjusting the particle size of a specific copolymer and introducing a surfactant. However, there is no teaching that would lead the ordinary artisan to reasonably believe that adding the '604 polymer to the very different hairspray

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

composition of Sramek, which uses hydrocarbon based solvent with only a minimal amount of water, would lead to enhanced freeze-thaw stability. The chemical arts are generally considered unpredictable. The differences between the '604 composition and the Sramek compositions make the likelihood of success in the present case even more unpredictable. Therefore, there is no reasonable expectation of success in combining the '604 polymer with the composition of Sramek.

Thus, for the reasons given above, there is no motivation for combining the teaching of the '604 reference with those of Sramek. Nor is there a reasonable expectation of success of imparting freeze-thaw stability by adding the copolymer of the '604 reference to the composition of Sramek. Therefore, the Office has failed to establish a *prima facie* case of obviousness and the rejection should be withdrawn.

Issues of New Matter, Lack of Written Description and Vagueness

Regarding the issues of new matter and lack of written description with respect to the term "acrylates/hydroxyesters acrylates", Applicant has shown, as discussed above, that there is written description for acrylates/hydroxyesters acrylates at least back to August 9, 1996, the filing date of the parent. Therefore, Applicant asserts that these issues are overcome.

Regarding the issue of vagueness as to the definition of "acrylates/hydroxyesters acrylates" set forth on page 4 of the Office Action, Applicant asserts that "acrylates/hydroxyesters acrylates" is a well known term of art as set forth on page 27 of

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000

the ICID, a copy of which was submitted to the Office along with the Supplemental Amendment filed July 30, 1999. Therefore, there is no issue of vagueness.

CONCLUSION

For the reasons of record, set forth in Responses in the parent case and in the present Response, Applicant maintains that a *prima facie* case of obviousness has not been established by the Office. The Office has neither demonstrated that one of ordinary skill would be motivated to combine and modify the references to arrive at the claimed subject matter, nor has the Office demonstrated that there would be a reasonable expectation of success of such a combination.

For at least these reasons Applicant respectfully requests withdrawal of the rejection under § 103.

In view of the above remarks, it is urged that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration and timely allowance of the pending claims.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Response, such extension is hereby requested. If there are any fees due under 37 C.F.R. § 1.16 or 1.17 which are not enclosed, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge those fees to our Deposit Account No. 06-916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 5, 2001

By: 
Matthew Whipple
Reg. No. 47,217

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000